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JENKINS & WILSON, PA 3100 TOWER BLVD SUITE 1400 DURHAM, NC 27707			SCHLAK, DANIEL K	
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			3653	

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,853

Applicant(s)

MIDDELBERG ET AL.

Examiner

Daniel K Schlak

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 34-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 25-33 is/are rejected.
- 7) ☒ Claim(s) 23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.6.11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Claims 34-76 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups II-VI, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10.

Applicant alleges that the restriction between Group I and Group II should have been under combination/subcombination and not subcombinations usable together. Following the allegation, "subcombinations usable together would be proper if the claim groups recited entirely different elements which are usable together. However, this does not apply." It does apply. One group has rotatable elements, the other does not. The other has a third staging area, the one does not. The rotatable elements and the third staging area are not mutually exclusive. When a Group (A, for instance) has a feature a1, and Group B has feature b1, and b1 is not in A and a1 is not in B, then the situation is one of subcombinations usable together. It can always also be argued that the relationship is of combination-subcombination, but this is more a matter of point-of-view than of precedent or fact. Perhaps, in this case, Group I might be a combination over Group II, or perhaps Group I is the subcombination. Regardless, the Examiner made sure to meet the criteria for combination-subcombination as well as those for subcombinations usable together, so that in the event that an argument were to be made that one group were much more broad than the other, the actual separability of

Art Unit: 3653

the groups would not be affected. In other words, two-way distinctness was demonstrated. Each has its own element, not mentioned in the other. Each has its own utility, put forth in lines 1 and 2 of page 3 of the prior action. In fact, the only way that Applicant could maintain that Group I and Group II are not distinguishable would be to state on the record that the third staging area *is in fact* the rotatable elements.

Applicant further alleges that the supposedly required combination/subcombination restriction requires a showing that the combination does not require the particulars of the subcombination and that the subcombination can be shown to have utility in other and different relations. However, the Examiner cannot even tell from the Applicant's arguments *which* is the combination and which is the subcombination. Certainly Group I does not require rotatable elements, and Group II does not require a 3rd staging area. Both groups can be shown to have utilities by themselves (as described already), and both can be shown to have different relations, such as one has a 3rd staging area and one has rotatable elements. The rotatable elements don't just levitate in space, and the 3rd staging area might be just about anything so long as it comprises a bit of the 2nd.

The Examiner, according to Applicant, does not provide a meaningful explanation of separate utility. Applicant is reminded that the Examiner cannot possibly write two or three pages on the possible utilities of different groups, when a simple and believable statement can be made to show the difference. How could two groups, one with an extra surface and the other with rotating elements, *not* find different utilities? The extrapolations are endless, and there is no need to dilute the subject matter of the

action postulating what might be done with each one. Perhaps the rotating elements press the water out of every fifth passing item and perhaps the 3rd staging area is used to set up a doll house. The Examiner does not have the time nor the resources to expound on every restriction requirement when the separate elements are obviously distinctly claimed and shown in the drawings.

As pertains to the arguments against the separation of Groups III and II, applicant argues that the fact that the subcombination may operate without the upstream device does not establish separate utility from the combination. So, the idea that Group II might and quite possibly *could* have a ream of paper sitting in the first staging area, conveying sheets from the ream instead of from an upstream device, has no pertinence to the utility of an upstream device? This allegation is groundless.

As pertains to the arguments against the separation of Groups IV and I, it has been purported that the Examiner has changed the claim language. The Examiner has no intention of changing claim language. If Applicant will kindly turn to claim 51 and read a few lines, it was the claims themselves which provided the movement of the adjustable conveying member. The Examiner's assertion was that, although claim 1 is mentioned as adjustable, certainly it can be used without adjustments being made. In fact, perhaps days could pass without adjusting the collector of claim 1. How then could Applicant say that the Examiner has not shown that the conveying device could be used to practice another and materially different process? The materially different processes are a) one in which the conveying element is moved and b) another in which movement does not take place.

As pertains to the arguments against the separation of Groups V and I, applicant alleges that it is irrelevant that the "method can be used to transport stacks." This was added by the Examiner to re-enforce the separability, and in no way negates the existence of the next line, wherein the Examiner gave due example of the "another materially different apparatus" that may be used for the process claimed, namely, one that has no adjustable element. At the top of page 5 of the response, Applicant alleges that the Examiner states that the apparatus of Group 1 "can be used in an environment with no moving of an adjustable element." This, Applicant states, means that the element is stationary, and that the assertion by Examiner does not correspond to the claims of Group 1. However, if Applicant will kindly read over again the quoted passage, the Examiner never said that Group V could be used without the adjustable element. The Examiner only said that the invention of Group V could be used without the movement of an adjustable element. As Applicant stated just a few pages earlier, it behooves no one involved to put words into each other's mouths. Claim 1 can be used *without adjusting* and therefore would not be performing the method of Group V.

As pertains to Groups III and II, applicant states that Examiner must allege some other purpose which the subcombination itself as claimed would have separate utility. This has already been done, when the Examiner stated that the subcombination could operate without an upstream device. If the subcombination were used without an upstream device, it would have to have its own source of fed items. This, it seems, would be quite a different device than one which requires an upstream device.

As pertains to the restriction requirement between Groups IV and III and Groups V and III, both on the grounds that the process is different from the apparatus, Applicant is directed to the above paragraph, wherein it has been shown too many times already that a sheet-feeding device operating without an upstream device finds example in itself, by offering the potential aspect of being its own source of material. The Examiner is not going to find art, or draw pictures, to give evidence that another embodiment is viable. If this were the requirement, restriction would be useless. When the Examiner offers the scenario of an embodiment capable of use without an item, the suggestion automatically conveys the idea of the materially different device or method which could be conceived, and the "reasonable examples" have been provided. The fact that a process can be practiced without an element of the apparatus does not show any material difference. How could this *ever* be said? How is a device, minus one of its potentially patentable features, not a materially different device? Applicant is reminded that restriction is made before the art is of record, and therefore all elements of a claim are initially conceived as bearing potential patentability. If a device comprises elements A, B, C, and D, and then a method comprises using A, B, and C, unquestionably the device without D is a different device. In other words, the omission of an element is just as substantial as the addition of an element in creating a device.

As pertains to the restriction requirement between Groups IV and II and Groups V and II, Applicant repeats that it is up to the Examiner to provide reasonable examples. The Examiner asserts that a claim for a device omitting an element is a claim for a different device. Later comes into question the burden upon the Examiner. The

Art Unit: 3653

Examiner has already deemed it undue and refuses to re-group these claims. As the grounds for restriction are proper, there will be no retraction of the restriction requirement. How does Applicant know what a reference found by the Examiner might or might not comprise? The Examiner's shoes don't have rotatable elements, and not surprisingly they would be found during a search on the apparatus but unfortunately do not read on the process

As pertains to Groups IV and V, Applicant alleges that, because the Groups comprise similar subject matter, they cannot be subcombinations usable together. If they had *no* common elements, they would be divergent subject matter. A claim with A, B, and C is restrictable from a claim with A, B, and D. This is the nature of the subcombinations usable together, and the Examiner has shown C and D for the pair of groups. If Applicant feels every claim should be restricted, it is no business of the Examiner's. Claims to be searched together will have the same base elements and will not diverge after A and B. Groups IV and V have adequate distinction in elements, such as Group V doesn't even mention a flats position and Group IV doesn't mention at all transporting a letter to the second staging area, although this is important to Group V. How could these claims be seen as belonging together?

The same follows for the restriction between Groups VI and I. Although no direct allegation has been made, Applicant repeats the assertion that practicing a process without an element of an apparatus does not show any difference to practicing it with the original apparatus. This has been shown to be not true. If the element is unimportant, let it be left out. If it is important, then it should be left in.

The method, by failing to mention the element, opens up the search and the scope of the art to be applied considerably, and it is not for the Examiner nor is it for the Applicant to predict what might be found in a search. Different elements in different claims send a searcher down different paths, and given that most claims begin with anywhere from 70% to 90% of art-known structural limitations, followed by a few lines of what the Applicant considers patentable, small things count a lot and they can have everything to do with the search and the burden is to be deemed undue or acceptable by the Examiner and not by the Applicant and it has been deemed undue and therefore no claims will be re-joined at any point save they be made to resemble adequately other claims with which it is sought to rejoin them.

The Examiner believes the refutation of the foregoing arguments adequately refute as well the arguments of pages 9 and 10 of the response. Again, an apparatus minus an element, considering the element was important enough to put forth in a claim, is inherently a materially different apparatus.

In summary, all arguments concerning the provisionally elected Group I have been countered directly, and the divisibility via restriction of Groups VI and III, Groups VI and II, Groups VI and IV, and Groups VI and V, indirectly via prior arguments.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 11, 12, 16-22, 25-29, and 31-33 are rejected under 35

U.S.C. 102(b) as being anticipated by US 4,219,191 to Rastorguyeff.

Rastorguyeff teaches a collector apparatus adapted for handling flat and letter units, the apparatus comprising a first staging area comprising a first staging surface and a first stage transport assembly, a second staging area generally disposed downstream from the first staging area, the second staging area comprising a second staging surface and a second stage transport assembly, a third staging area comprising at least a portion of the second stage transport assembly, and a conveying device adjustable between a flats mode position and a letters mode position, wherein in the letters mode position, a first material flow path is defined through the first and second staging areas, and in the flats mode position, a second material flow path is defined through the third staging area. The first stage transport assembly comprises a movable first endless member. The second stage transport assembly comprises a second endless member. The conveying device comprises a retractable first conveying assembly, the retractable first conveying assembly is extended over at least a portion of the first staging surface in the flats mode position of the conveying device, and the

Art Unit: 3653

retractable first conveying assembly is retracted to expose the first staging surface in the letters mode position. The retractable first conveying assembly comprises a movable first endless belt, the movable endless belt is extended over at least a portion of the first staging surface in the flats mode position of the conveying device, and the movable first endless belt is retracted to expose the first staging surface in the letters mode position.

An input device operatively communicates with an upstream end region of the first staging area in the letters mode position, and operatively communicates with an upstream end region of the third staging area through the conveying device in the flats mode position. The retractable first conveying assembly comprises a first rotatable element, the first rotatable element disposed at an upstream end region of the first staging area in the letters mode position, and alternatively disposed at a downstream end region of the first staging area in the flats mode position. The retractable first conveying assembly comprises a first endless belt movable about the first rotatable element. The retractable first conveying assembly comprises a second rotatable element disposed at first elevation in the letters mode position, and alternatively disposed at a second elevation in the flats mode position, and wherein the second elevation is higher than the first elevation. The retractable first conveying assembly comprises a first endless belt movable about the first and second rotatable elements. The conveying device comprises a second conveying assembly, the first conveying assembly includes a movable first endless belt, the second conveying assembly

Art Unit: 3653

includes a movable second endless belt, and the second material flow path runs between the first and second endless belts. An input device operatively communicates with an upstream end region of the first staging area in the letters mode position, and operatively communicating with an upstream end region of the third staging area through the first and second endless belts in the flats mode position.

The conveying device comprises a material unit guiding component adjustable between the flats mode position and the letters mode position, and wherein, in the letters mode position, the guiding component is disposed at a first elevation at which the guiding component is adapted to at least partially define the first material flow path, and in the flats mode position, the guiding component is disposed at a second elevation higher than the first elevation.

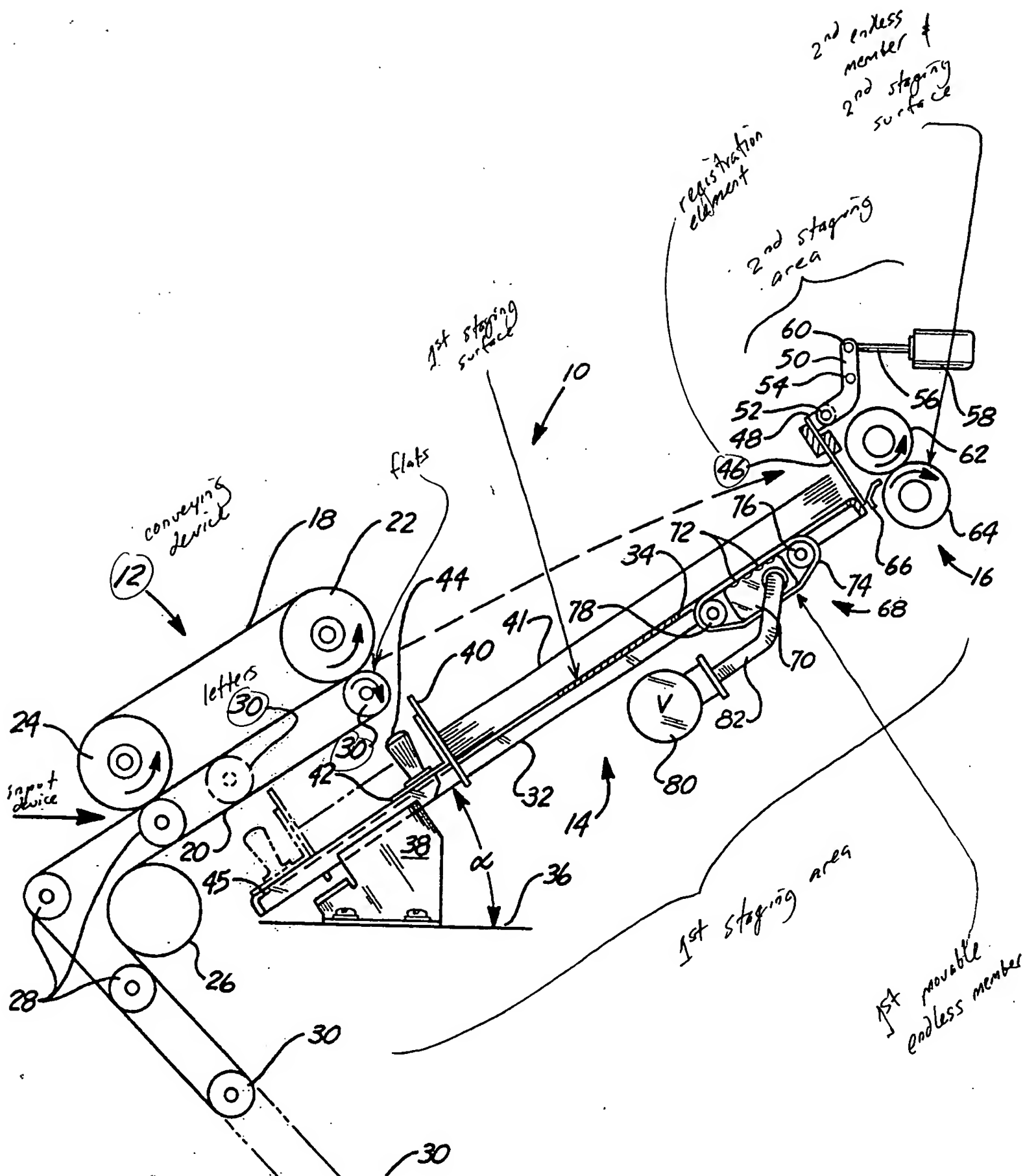
The conveying device comprises a material unit guiding component adjustable between the flats mode position and the letters mode position, and wherein, in the letters mode position, the guiding component is disposed at a first elevation at which the guiding component is adapted to at least partially define the first material flow path, and in the flats mode position, the guiding component is disposed at a second elevation higher than the first elevation. The apparatus further comprises an input device an upstream end region of the first operatively communicating with staging area in the letters mode position, and operatively communicating with an upstream end region of the third staging area through the conveying device in the flats mode position. The input device is supposed by an upstream material unit processing device. An output device is taught operatively communicating with a downstream end of the second staging area.

Art Unit: 3653

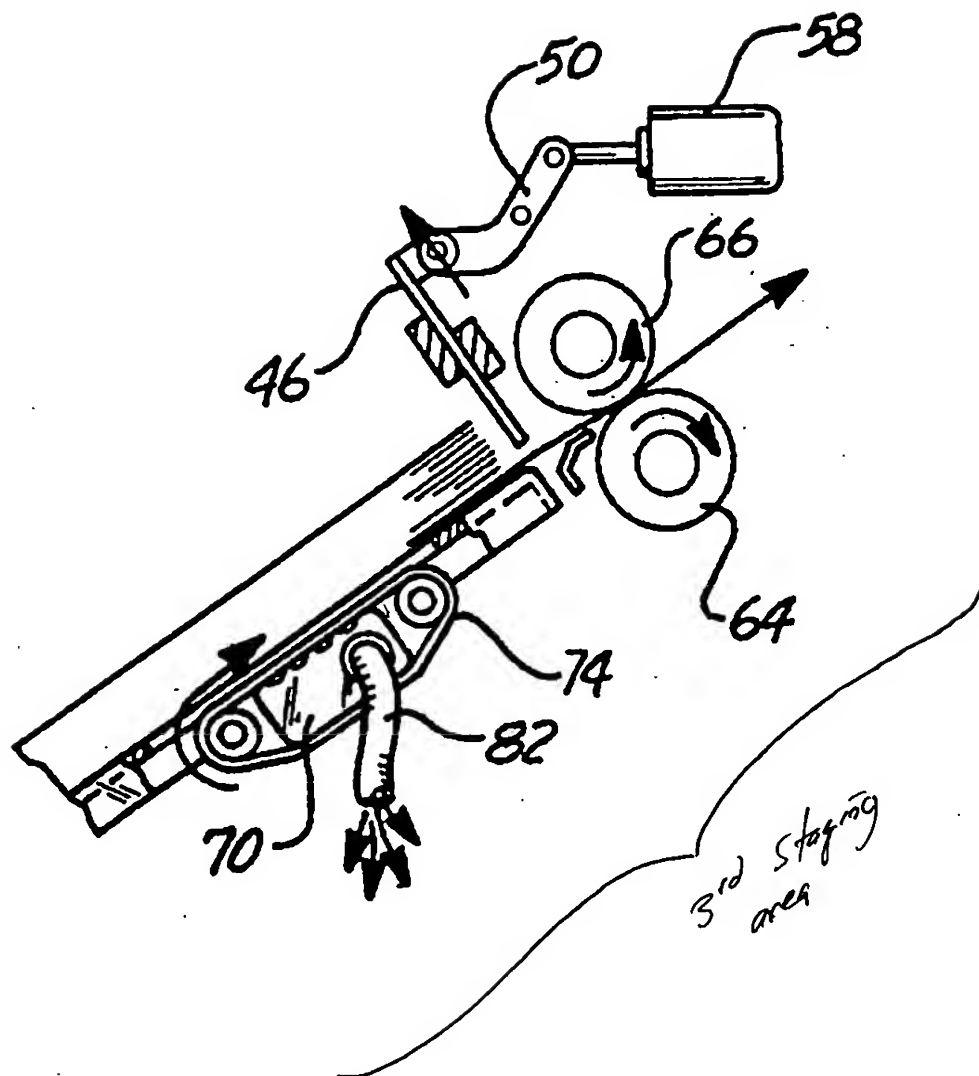
The following two pages comprise excerpts from the reference, namely figures 1 and 2 of Rastorguyeff, to aid applicant in understanding the nature of the rejection.

Figure 2 has been included to show the extent of the third staging area.

Art Unit: 3653



Art Unit: 3653



Art Unit: 3653

Claims 1-18 and 26-33 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,899,453 to Middleberg et al.

Surely Applicant is familiar with this reference. The only point of contention, as most of the device is almost exactly the same as the device of the instant application, should be whether or not there is a conveying device adjustable between flats mode and letters mode, wherein in letters mode a first flow path is defined, and in the flats mode a second flow path is defined. The Examiner asserts that, as there is no claim limitation *in the claims rejected here* that further defines the device in a way that does not read on '453. The Examiner asserts that elements 50A and 52A of figure 3 teach a retractable first conveying assembly which is adjustable (it swings on the arm for adjustments up and down) to change the flow path.

In both rejections under 35 U.S.C. 102, Applicant is reminded that the third staging area, in the instant application and in the references, is nothing more than most of the first staging area and part or most of the second staging area. No liberties have been taken in interpreting it thus, as Applicant has done exactly this. Thus, no matter what the flow path, it necessarily passes through all three flow paths all the time. The movable/retractable first conveying assembly, and what it comprises or how it acts, does not change the existence of the staging areas and how they are interpreted, particularly since the instant application is an improvement on '453. In other words, since '453 teaches everything of the claims rejected under it, including a retractable first conveying assembly that is shown clearly capable of adjustment up and down, one of

Art Unit: 3653

the positions (flats) finds the assembly higher and/or retracted, and the other (letters) lower. In the flats position the movable endless belt of the retractable first conveying element extends over a portion of the first staging surface, and in the letters mode it is "retracted", that is, pulled away from the flow path to expose the first staging surface.

In other words, the retractable first conveying assembly of the claims must be further defined to not read on the adjustable elements (52A, 52B, 52C) of the '453 reference, and the flow paths and/or staging areas must be further defined to not read on Rastorguyeff.

Other than the nature of the third flow path in Rastorguyeff, and the nature of the retractable first conveying assembly, Examiner trusts that the remainder of the elements in each reference will speak for themselves, as they are clearly shown and described in the references.

Allowable Subject Matter

Claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rastorguyeff does not teach biasing the rotatable elements toward one elevation or another with a biasing component.

Conclusion

Art Unit: 3653


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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